

### **Remarks**

Entry of the amendment is respectfully requested. No new matter has been added.

Reconsideration is respectfully requested.

### **In the Drawings**

Enclosed with this Response, and forming a part thereof, are corrected drawings for Figures 22 and 29 addressing the Examiner's objections. In particular, in Fig. 29, the lead line from reference numeral 264 has been corrected to identify the roller bore and not the shaft. Fig. 29 has also been corrected to indicate that the deformable fingers are identified by reference numeral 262. Also, in Fig. 22, a lead line has been added to extend between reference numeral 224 and the shaft. No new matter has been added to Applicants' disclosure.

### **In the Specification**

In the Action, the Examiner objected to the abstract as not directed to the claimed invention. This rejection is respectfully traversed. However the Abstract has been amended.

The Examiner objected to the title of the invention as not being descriptive. Applicants respectfully traverse this objection. The claims are directed to a cash dispensing automated banking machine. Further, the recited roller features and related steps are particularly useful in a deposit accepting system in the machine.

The specification has been amended as above to correct typographical errors and inconsistencies with regard to reference numerals. No new matter has been added to Applicants' disclosure.

### **Claim Status**

In the Action, claims 6-16 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In particular, the Examiner points out that claim 6 uses the term "the housing of an automated banking machine" without proper antecedent basis.

Claims 1-6 and 17-19 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Barela (U.S. Patent 5,924,157).

Claims 7-16 and 20 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. The early indication of allowable subject matter is appreciated.

### **The Claim Amendments**

New claim 21 has been added to the subject Application. Claim 21 incorporates the subject matter of original claim 7, which the Examiner indicated as allowable over the cited art.

New claim 22 has been added to the subject Application. Claim 22 incorporates the subject matter of original claim 20, which the Examiner indicated as allowable over the cited art.

Claim 8 has been amended to depend from new claim 22. It is believed that the amendment to claim 8 does not affect the scope of claim 8 as originally filed.

Claims 3 and 5 have been amended to correct informalities in the claims and not by reason to limit the scope of the original claims.

### **35 U.S.C. § 112 Rejections**

Claim 6 has been amended to recite “a housing of an ATM.” It is respectfully requested that the rejection be withdrawn.

### **35 U.S.C. § 102 Rejections: The Applicable Legal Standards**

Anticipation pursuant to 35 U.S.C. § 102 requires that a single prior art reference contain all the elements of the claimed invention arranged in the manner recited in the claim. *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 220 USPQ 193, 198 (Fed. Cir. 1983).

Anticipation under 35 U.S.C. § 102 requires in a single prior art disclosure, each and every element of the claimed invention arranged in a manner such that the reference would literally infringe the claims at issue if made later in time. *Lewmar Marine, Inc. v. Barient, Inc.*, 822 F.2d 744, 747, 3 USPQ 2d 1766, 1768 (Fed. Cir. 1987).

Anticipation is established only when a single prior art reference discloses, expressly or under principles of inherency, each and every element of a claimed invention. *RCA Corp. v. Applied Digital Data Sys., Inc.*, 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984).

### Claim 1

Applicant's traverse the Examiner's characterization of claim 1 as merely drawn to a use of the invention. Applicants' claims are directed to a method including extending a shaft of a *cash dispensing automated banking machine* in a cylindrical opening in a body of a *banking machine roller*. In determining the scope of the claims, the Examiner is not permitted to ignore features and relationships explicitly recited therein.

Barela fails to provide a shaft of a cash dispensing automated banking machine. Barela fails to provide a banking machine roller. Thus, Barela does not anticipate Applicant's claim 1. Further, Barela does not suggest to one of ordinary skill in the art a modification of the shaft to provide *a shaft of a cash dispensing automated banking machine*, as claimed. Barela does not suggest modifying roller 16 to provide *a banking machine roller*, as claimed.

Thus, as claim 1 distinguishes from the cited art, Applicants respectfully request that this rejection be withdrawn.

### Claim 2

The comments directed to claim 1 apply equally well to claim 2 and are incorporated herein by reference. Further, the preamble of claim 2 recites: "wherein the at least one finger extends *adjacent a first axial end* of the body." The body of the claim recites: "moving the shaft relative to the cylindrical opening to engage an annular flat surface adjacent *a second axial end* of the body opposed of the first end, with *a radially outward extending annular step surface on the shaft*."

Barela fails to meet the features and relationships of Applicant's claim. The Examiner relies on Barela, col. 3, lines 20-25 and FIG. 2 to meet the features and relationships as recited in claim 2, while also relying on Barela, col. 4, lines 7-17 to meet the features and relationships as recited in claim 1. However, as taught and shown in the cited reference, col. 3, lines 20-25 are directed to the "inner end" of the shaft 24. A tapered collar 28 and annular recess 30 are located at this inner end. The annular recess 30 abuts an enlarged disc 32 which is mounted onto shaft end 34. As illustrated in FIG. 2, the inner end cap 50 of roller body 16 has a center hole 51 adapted to be positioned adjacent disc 32. The deflectable fingers 54 are integral with the inner end cap 50 and are adapted to move into annular recess 30. Thus, although the claim recites features and relationships *at opposed ends* of the roller body, the Examiner improperly relies on teachings directed to the *same end* of the shaft/roller body of Barela.

The cited reference therefore fails to teach or suggest the recited claim features. Further, there is no teaching or suggestion in Barela that would lead one of ordinary skill in the art to modify the reference to meet the requirements of the claim. It is respectfully requested that the rejection be withdrawn.

### **Claim 3**

The comments directed to claims 1-2 apply equally well to claim 3 and are incorporated herein by reference.

#### **Claim 4**

The comments directed to claims 1-3 apply equally well to claim 4 and are incorporated herein by reference. Further, the preamble of claim 4 recites: “wherein the at least one finger is inwardly biased and extend axially outward from the first end.”

Barela fails to teach the features and relationships of the claim. For example, the deflectable fingers 54 do not extend axially outward from the first end of the roller body 16. In fact, with reference to Figure 2, the deflectable fingers 54 extend axially inwardly with respect to end cap 50. Further, there is no teaching or suggestion that Barela be modified in provide inwardly biased fingers that extend axially outward.

#### **Claim 5**

The comments directed to claims 1-4 apply equally well to claim 5 and are incorporated herein by reference.

#### **Claim 6**

The comments directed to claims 1-5 apply equally well to claim 6 and are incorporated herein by reference. Additionally, Applicants traverse the Examiner’s disregard for their prerogative in choosing how to claim the subject matter of the invention. In this method claim, the shaft is engaged in supporting connection with a housing of an automated banking machine. The features and relationships of the claim are not shown or taught in Barela. Thus, Barela can not anticipate the claim. It is respectfully requested that the rejection be withdrawn.

### **Claim 17**

Applicants' claim is directed to a roller adapted to be used in a cash dispensing automated banking machine. Further, Applicants claim a body with a cylindrical opening adapted to accept a shaft of the banking machine. Barela fails to meet the features and relationships as set forth in Claim 17.

### **Claim 18**

The comments directed to claim 17 apply equally well to claim 18 and are incorporated herein by reference. Additionally, the claim recites: "each of the fingers extend both radially inward and axially outward in a first direction relative to the body." The deflectable fingers shown in Barela (FIG. 2) extend *axially inward* relative to the body. Thus, the reference fails to meet the features and relationships recited in the claim. Further, there is no teaching or suggestion in Barela to provide deflectable fingers according to Applicants' claim. It is respectfully requested that the rejection be withdrawn.

### **Claim 19**

The comments directed to claims 17-18 apply equally well to claim 19 and are incorporated herein by reference. Further, the claim recites "an annular flat surface adjacent a second end of the body opposed of the first end, wherein the annular flat surface is adapted to engage a radially outward annular step surface on the shaft." As set forth in the comments directed to claim 2 above, the Examiner's reliance on Barela, column 3, lines 20-25 is faulty. Barela's teaching at column 3, lines 20-25 is directed to the inner end of the shaft 24. Barela's

teaching at column 4, lines 7-17 is directed to the inner region of the roller body 16. Thus, Barela fails to meet the features and relationships of claim 19, especially with regard to structures at the first and second axial ends of the claimed roller.

#### **Claim Fees**

Please charge fees for one additional independent claim (in excess of three) at \$200 each, and fees for two additional claims (in excess of 20) at \$50 each for a total of \$300 to Deposit Account No. 09-0428 (Interbold).



### Conclusion

Each of Applicants' claims have been shown to be allowable over the cited references. Thus, it is believed that the application is in condition for allowance. The undersigned will be happy to discuss any aspect of the Application by telephone at the Office's convenience.

Respectfully submitted,



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